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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/308,451	05/19/1999	ROBERT G. SCHWARTZ	8001.104/00	6174

7590 03/07/2003

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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/308,451

Applicant(s)

SCHWARTZ ET AL.

Examiner

Sam Rimell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 and 89-106 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-45, 89-106 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:


SAM RIMELL
PRIMARY EXAMINER

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Preliminary Note: This office action is not made final, due to the application of a new grounds of rejection to claims 40-45.

Claims 2-6, 8-12, 14-19, 21-24, 27-32, 35-39 and 41-45 are objected to under 37 CFR 1.75 (c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The reasons for this objection were set forth in the Office action of January 2, 2002 and are hereby incorporated by reference.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-39 and 89-106 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitney et al. ('834).

The reasons for the rejection of claims 1-39 were set forth in the office action of January 2, 2002 and are hereby incorporated by reference.

Claims 89-90, 92-93 and 95-96, 101-102 and 104-105 are addressed to the inclusion of a printer and a mailpiece, both of which are features disclosed in Whitney et al. In particular, Whitney et al. discloses a printer (19) and mailpiece (graphically illustrated in FIG 9). In this group of claims, the indicium on the mailpiece is functionally recited as an intended output of the printer, and accordingly, is not attributed patentable weight.

Claims 91, 94, 97-100, 103 and 106 are addressed to a mail piece having the indicium (alternatively referred to as "representation") on the mail piece. These claims invoke

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consideration of *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), since they are addressed to consideration of the patentability of printed matter on a substrate. *In re Gulack* states: “Printed matter that is not functionally related to the substrate does not distinguish invention from prior art in terms of patentability; although printed matter must be considered, in that situation, it may not be entitled to patentable weight.” In the present case of postal elements imprinted upon a mailpiece, examiner finds that the printed matter is not functionally related to the substrate. Evidence of this can be seen from the fact that the printed matter does not alter the function of the mailpiece when it is applied to the mailpiece. In applicant’s invention, the mailpiece is an envelope. The function of an envelope is to serve as a container for relatively small parcels, such as letters. The function of the envelope as a container is not altered by the application of postal indicia. The envelope still remains a container for small parcels, regardless of any indicia applied to its outside surface. Since the functionality of the envelope is not altered by the application of postal indicia, there is apparently no functional relationship between the indicia and its substrate (the envelope). Thus, in accordance with *In re Gulack*, no patentable weight can be attributed to the nature of the printed matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilham (U.S. Patent 5,200,903).

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Gilham discloses a first print head (28) and a second print head (31) separated by a gap (col. 4, lines 24-29). Claims 40-45 are only directed to an apparatus composed of first and second separated print heads. All of the remaining elements are functionally recited and carry no patentable weight.

Remarks

This office action has not been made final.

Applicant has amended claims 1, 7, 13, 20, 26 and 34 by only deleting the recitation of the printer. For claims rejected under 35 USC 102, simply deleting elements from the claims will not render them patentable. Furthermore, deleting the recitation of the printer does not alter how the remaining portions of the claims are interpreted. Claims 1-39 thus remain rejected as in the previous action.

Claims 40-45 have been rejected under 35 USC 102(b) as being anticipated by Gilham. This rejection changes the previous grounds of rejection from 35 USC 102(d) to 35 USC 102(b).

Claims 89-106 are newly presented claims, and are addressed in the discussion of the Whitney et al. reference.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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